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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/633,937	08/08/2000	Patrick Egan	20181-2	4122

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EXAMINER

NGUYEN, CHI Q

ART UNIT

PAPER NUMBER

3637

DATE MAILED: 11/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/633,937

Applicant(s)

EGAN, PATRICK

Examiner

Chi Q Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitations: "a jamb member securable" in line 1, page 3 "said jamb is assembleable substantially flush therewith", line 7, page 3 are indefinite because there's no positive connection between the panel, the jamb member and the drywall. The language "plus/minus ¼ inch" is also indefinite as the dimension is unascertainable. Applicant is advised to delete it.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 24-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porter (U.S. 5,771,645) in view of (US 5,497,589).

Porter (-645) discloses an electrical access in structural insulated foam core panels 10 comprising a first and second exterior facing sheets made from plywood, drywall, or composite gypsum 12, 14, at least two framing struts 50, 52 being located

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between the first a first and second interior facing into foam core 16, an insulated foam core 16, an electrical box 42, electrical conductors 78, 80, wire chase 20, apertures 60, 64, a first replacement plug 26 serves as a jamb member adjacent at least one of the struts 50, a second replacement plug 36 serves as a trim piece, a window opening 34 is partially defined by strut members 50, 52 (see Figs. 1, 5-6).

Porter (-645) does not disclose expressly the pre-fabricated wall panel has a first vertical side edge having a male projection member adapted to project into a corresponding female reception member on an adjacent panel.

Porter (-589) teaches a structural insulated panels including a first vertical side edge having a male projection member with edge strips 129a, 129b, adapted to project into a corresponding female reception member on a adjacent panel with edge strips 134a, 134b (see Fig. 7).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Porter's (-645) invention with Porter's (-589) for the panel edges having male projection and female reception, respectively. The motivation for doing so would have been to provide wall panel edges flush therein with better engagement.

5. Claims 24, 27, 28, 32, 33, 35, 36, 40-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Porter (U.S. 5,771,645) in view of Porter (U.S. 5,497,589)

Porter (-645) and (-589) disclose the claimed invention except for the tolerance of the thickness of the struts, panel, and the insulation R-value through a foam containing portion of the thickness of at least 20. It would have been obvious to one

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having ordinary skill in the art at the time of the invention was made to obtain critical tolerance of the thickness, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Furthermore, all the conventional foaming panels have specific thickness and R-value for better insulation in order to have energy cost saving. Thickening the panels, higher R-value, these are engineering design choices.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Eckel (US 4,038,796), McKitrick (US 6,218,612), Polhamus (US 3,377,756), Fragale (US 5,090,174), DenAdel (US 5,678,381), Long (US 6,276,104), Humphrey (US 5,722,208), Gretz (US 6,180,878), Driscoll (US 4,135,775), Arfert (US 5,090,175), Williamson (US 5,653,075), Ramirez (US 5,519,971), Lopina (US 3,487,598), Palmersten (US 6,256,959), Ary (US 3,831,335), JP 6-88386, 6-288024, 6-136864, 6-57857, 5-263483.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chi Q. Nguyen whose telephone number is (703) 605-1224, Monday-Thursday (7:00-5:30), Fridays off or examiner's supervisor, Lanna Mai can be reached at (703) 308-2486. The fax number for the organization where this application or proceeding assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



CQN
10/30/02

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